REMARKS

Claims 25, 29, 31-43 are pending in the application; of these, Claim 37 stands withdrawn from consideration. No claims are amended in this Response.

Applicants acknowledge the Examiner's withdrawal of all of the rejections made in the Office Action dated March 17, 2004.

Claims 25, 29, 31-36 and 38-43 have been rejected by the Examiner under the judicially created doctrine of obviousness-type double patenting. Applicants traverse the rejections of Claims 25, 29, 31-36 and 38-43 and the withdrawal of Claim 37 as discussed below.

The "Double-Patenting" Rejections of Claims 25, 29, 31-36, and 38-43 over U.S. Patent No. 6,133,426 in view of Griffiths et al. (WO 96/09325)

Claims 25, 29, 31-36 and 38-43 stand rejected under the judicially created doctrine of obviousness-type double patenting over Claims 1-3, 5-6, 12, and 15-17 of U.S. Patent No. 6,133,426 in view of Griffiths et al. (WO 96/09325).

As noted by the Examiner, a timely filed Terminal Disclaimer in compliance with 37 C.F.R. §1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground, provided the conflicting application or patent is shown to be commonly owned with this application.

Without acquiescing to the rejections, Applicants provide a Terminal Disclaimer over U.S. Patent No. 6,133,426. Applicants note that the present application and U.S. Patent No. 6,133,426 are owned by the same assignee, Genentech, Inc. The inventors of the present application, employees of Genentech, Inc., had an obligation to assign their rights in the invention to Genentech, Inc., and did assign their rights in the invention to Genentech, Inc. (with regard to the parent application, U.S. Application Serial No. 09/234,182, of which the present application is a continuation application). These assignments were recorded with the United States Patent and Trademark Office on May 20, 1999 at reel 010021 and frame 0349. The inventors of U.S. Patent No. 6,133,426, also employees of Genentech, Inc., assigned their rights to Genentech, Inc. as recorded with the United States Patent and Trademark Office on August 6, 1999 at reel 010150 and frame 0283.

Accordingly, Applicants submit that the rejections of Claims 25, 29, 31-36 and 38-43 over U.S. Patent No. 6,133,426 in view of Griffiths under the judicially created doctrine of obviousness-type double patenting are overcome.

By virtue of their employment, the inventors of U.S. Patent No. 6,133,426 were under an obligation to assign their rights in the invention to Genentech, Inc. at times prior to the recordation of the assignment with the United States Patent and Trademark Office. Thus, the inventors of U.S. Patent No. 6,133,426 had an obligation to assign their rights in that invention to the present assignee at the time the invention in the present application was made. Accordingly, rejection under 35 U.S.C. §103(a) based on the commonly assigned case as a reference under 35 U.S.C. §102(f) or 35 U.S.C. § 102(e) is believed to be precluded.

The "Double-Patenting" Rejections of Claims 25, 29, 31-36, and 38-43 over U.S. Patent 6117980 in view of Griffiths et al. (WO 96/09325)

Claims 25, 29, 31-36 and 38-43 stand rejected under the judicially created doctrine of obviousness-type double patenting over Claims 1-3, 8-9, 11, and 18 of U.S. Patent No. 6,117,980 in view of Griffiths et al. (WO 96/09325).

Without acquiescing to the rejections, Applicants provide a Terminal Disclaimer over U.S. Patent No. 6,117,980. Applicants note that the present application and U.S. Patent No. 6,117,980 are owned by the same assignee, Genentech, Inc. As noted above, the assignment of rights in the present application to Genentech, Inc. was recorded with the United States Patent and Trademark Office on May 20, 1999 at reel 010021 and frame 0349. The inventors of U.S. No. Patent 6,117,980 assigned their rights in these inventions to Genentech, Inc. as recorded with the United States Patent and Trademark Office on May 19, 1997 at reel 008509 and frame 0650. Thus, the inventions were commonly owned at the time the invention in this application was made.

Accordingly, Applicants submit that the rejections of Claims 25, 29, 31-36 and 38-43 under the judicially created doctrine of obviousness-type double patenting over U.S. Patent No. 6,117,980 in view of Griffiths are overcome. In addition, the fact that

the inventions were commonly owned at the time the invention in the present application was made is believed to preclude rejection under 35 U.S.C. §103(a) based on the commonly assigned case as a reference under 35 U.S.C. §102(f) or 35 U.S.C. §102(e).

The Withdrawn Claim 37

Applicants note that Claim 37 stands withdrawn as allegedly pertaining to subject matter withdrawn from consideration. Applicants note that the Examiner stated that "rejoinder of the claims reciting at least 40 kD would be appropriate upon allowance of claims reciting "at least 20 kD" (page 2, paragraph 4 of the final Office Action). As indicated in the Remarks and in view of the Terminal Disclaimers accompanying this Response, Applicants respectfully submit that claims reciting "at least 20 kD" are in condition for allowance, and thus that rejoinder of the claims reciting at least 40 kD (*e.g.*, claim 37) is appropriate. Applicants respectfully request rejoinder of Claim 37, and consideration and allowance of Claim 37.

CONCLUSION

Applicants believe that all pending claims are in condition for allowance. Accordingly, reconsideration and allowance of all claims is respectfully requested.

Please charge any fees, including any additional fees for extension of time, or credit overpayment to Deposit Account No. **08-1641**, referencing Attorney's Docket No. **39766-0093 C1**). Please direct any calls in connection with this application to the undersigned at the number provided below.

Respectfully submitted,

Date: October 13, 2004

By: _____
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